

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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| In re Patent Application of<br>KAURA                             | Examiner:<br>S. Hui         |
| Serial No.<br>09/825,258                                         | Docket No.:<br>146323.00001 |
| Filed:<br>April 3, 2001                                          | Group Art Unit:<br>1617     |
| For: Composition and method for treatment of respiratory disease |                             |

**RESPONSE TO RESTRICTION/ELECTION REQUIREMENT**

Honorable Commissioner of Patents  
and Trademarks  
Washington, D.C. 20231

**CERTIFICATE OF MAILING**

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231 on November 13, 2001.

By 

Sir:

In response to the Office Action mailed September 13, 2001, to which a response is due with a one-month extension of time by November 13, 2001, Applicant respectfully requests consideration of the following response:

**Response to Restriction Requirement**

With regards to the restriction between the invention of Group I, drawn to compositions for the treatment of asthma, and Group II, drawn to methods for treating asthma, Applicant elects without traverse the invention of Group I. Applicant notes that originally presented claims 1-13 and 19-22 have been canceled without prejudice. Claims 23-48 have been added, of which claims 23-35 correspond to the invention of Group I.

Applicant further notes that the MPEP at 821.04 directs that, if applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims which depend from or otherwise include all the limitations of the allowable product claim will be rejoined. Thus, although the restriction requirement is not traversed, Applicant requests rejoinder of applicable process claims upon a finding that any product claim or claims are allowable.

**Response to Election of Species Requirement**

With regards to the requirement for election of species, Applicant elects with traverse the following species:

**loratadine** as the elected species from the genus of histamine receptor antagonists;  
and  
**montelukast sodium** as the elected species from the genus of leukotriene receptor antagonists.

**Claims 13, 16, 18, 23-25, and 36-41** are generic to the elected species.

**Claims 14, 15, 17, 26-29 and 42** are, or depend on, Markush-type generic claims which include a plurality of alternatively usable species.

**Claims 30-35 and 43-48** each recite a single species from the genus of histamine receptor antagonists and a single species from the genus of leukotriene receptor antagonists.

**Claims 31 and 44** recite the elected species.

Applicant traverses the election of species requirement for two reasons:

**Reason 1**

Applicant traverses the requirement because, although claims 14, 15, 17, 26-29 and 42 are, or depend on, Markush-type generic claims which include a plurality of alternatively usable species, the Examiner has not indicated compliance with established Markush practice. The MPEP at 803.02 states that "should no prior art be found that anticipates or renders obvious the elected species, the search of the Markush-type claim will be extended. If prior art is then found that anticipates or renders obvious the Markush-type claim with respect to a nonelected species, the Markush-type claim shall be rejected and claims to the nonelected species held withdrawn from further consideration. The prior art search, however, will not be extended unnecessarily to cover all nonelected species. Should applicant, in response to this rejection of the Markush-type claim, overcome the rejection, as by amending the Markush-type claim to exclude the species anticipated or rendered obvious by the prior art, the amended Markush-type claim will be reexamined. The prior art search will be extended to the extent necessary to determine patentability of the Markush-type claim."

Applicant requests that the Examiner follow proper Markush practice as directed by the MPEP which directs that, should no prior art be found that anticipates or renders obvious the elected species, the search of the Markush-type claims should be extended as necessary to determine patentability of the Markush-type claims.

**Reason 2**

Applicant traverses the requirement because the Examiner has not indicated that, "[u]pon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the

limitations of an allowed generic claim as provided by 37 CFR 1.141" as directed by the MPEP at 809.02(a).

Applicant acknowledges that claims 30, 32-35, 43, and 45-48 are drawn to species other than the elected species, and thus acknowledges that claims 30, 32-35, 43, and 45-48 will be withdrawn from consideration. However, Applicant points out that claims 30-35 and 43-48 are written in dependent form or otherwise include all the limitations of one or more of claims 13, 16, 18, 23-25, and 36-41, which are generic to the elected species. Should any of generic claims 13, 16, 18, 23-25, and 36-41 be found allowable, applicant requests consideration of claims to the additional species that are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141.

#### ADDITIONAL REMARKS

Receipt of the Office Action mailed September 13, 2001 is acknowledged. In a preliminary amendment filed contemporaneously herewith, claims 1-13 and 19-22 were cancelled without prejudice, and claims 23-48 are added. **Claims 14-18 and 23-48 are now pending.**

**CONCLUSION**

In light of the above amendments and remarks, Applicant respectfully submits that all pending claims 14-18 and 23-48 as currently presented are in condition for allowance. If, for any reason, the Examiner disagrees, the Examiner is invited to call the undersigned attorney at 202-624-3947 in an effort to resolve any matter still outstanding *before* issuing an action. The undersigned attorney is confident that any issue that remains can readily be worked out by telephone.

Favorable reconsideration is respectfully requested.

Respectfully submitted,



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Date: Tuesday, November 13, 2001

TTM/yea